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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/564,066	01/10/2006	Jakob Blattner	72099	3956
23872	7590	08/29/2008		
MCGLEW & TUTTLE, PC P.O. BOX 9227 SCARBOROUGH STATION SCARBOROUGH, NY 10510-9227			EXAMINER DHINGRA, RAKESH KUMAR	
			ART UNIT 1792	PAPER NUMBER
			MAIL DATE 08/29/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/564,066

**Applicant(s)**

BLATTNER ET AL.

**Examiner**

RAKESH K. DHINGRA

**Art Unit**

1792

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 01 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 and 15-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-13, 15-26 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-13, 15-17, 20-23 drawn to apparatus (substrate storing device with controller).

Group II, claim(s) 18, 24, 25, drawn to apparatus (transport container for substrates with a locking means)

Group III, claim(s) 19, 26, drawn to process (for handling disk-shaped substrate).

The inventions listed as Groups I, II, III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Inventions of Groups I, II

Abe et al (JP 2001-291759) teach a device/method for storing plate-shaped substrates and comprising:

a plurality of consecutive storage elements 1 (with nail plate 2a) stacked in a stacked direction, each storage element accommodating at least one substrate 21;  
a stacking area associated with each of the storage elements. Abe et al also teaches moving

means 5 (with a control system) for moving a spring 6 relative to said stacked storage elements, said moving means moving said spring 6 with its first surface engaged with a first storage element such that a second surface of the spring engages a second storage element adjacent said first storage element (for example, Fig. 1, 9 and para. 0027, 0028, 0055-0058). Abe et al also teach a method of handling disk shaped substrates the method comprising providing a stack of separable storage elements 1, providing a spring 6 having a first portion with a first contact surface and a second portion with a second contact surface;

selecting one of said storage elements to define a selected storage element;

moving said stack of separable storage elements such that said spring 6 is positioned in an area adjacent said selected storage element, said spring engaging one of said storage elements located adjacent said selected storage element such that said first contact surface is in contact with said adjacent storage element;

The subject matter taught by Abe fully encompasses the technical features which the apparatus of group I and the process of group III have in common as indicated above. Thus the common technical features of the apparatus and the process as indicated above do not make a contribution over prior art (they are not considered special technical features). Further, the apparatus of Group I (substrate storing device with controller) and the process (for handling disk shaped substrates) have different special technical features, like, a tool having a first storage element contact surface and a second storage element contact surface, said first storage element contact surface engaging a first storage element, a control unit programmed for moving said tool via said moving means such that the tool divides the plurality of stacked storage elements into an upper stack and a lower stack etc (details as given in claim 1 - for apparatus of group I), and

selecting one of said storage elements for removal from stack of separable storage elements to define a selected storage element, moving said tool with said first contact surface in contact with said adjacent storage element and with said second contact surface in contact with said selected storage element such that said selected storage element is located at a spaced location from another adjacent storage element etc (details as given in claim 19). Thus, apparatus of group I and the process of group III do not relate to a single general inventive concept.

#### Inventions of Groups I, III

Further, regarding invention of group II (transport container for substrates with locking means) Nyseth et al (US 2002/0125170) and Matsuyama et al (US 6,238,283) teach a transport container comprising storage elements having a stacking area defined by storage element 94 in contact with another storage element 94, in a stacked location and having substrate depositing means 96 (e.g. Fig. 4, 6 and para. 0048). Thus subject matter of the prior art encompasses the common technical features of invention of group II as indicated above. Also as already indicated above, Abe et al teach common technical features of invention of group I viz. a plurality of consecutive storage elements 1 (with nail plate 2a) stacked in a stacked direction, each storage element accommodating at least one substrate 21; a stacking area associated with each of the storage elements, and moving means 5. However inventions of group I and II have different special technical features like, a device for storing plate shaped objects having a tool with first and second contact surfaces and a control unit programmed for moving the tool (for invention of group I), and a transport container with locking means for sealing the transport container (for

invention of group II). Thus, apparatus of group I and the apparatus of group II do not relate to a single general inventive concept.

#### Inventions of Groups II, III

Additionally as indicated above, invention of group II (transport container with locking means) and invention of group III (process for handling disk shaped substrates) have different special technical features, as already indicated above and thus do not relate to a single general inventive concept.

A telephone call was made to Brian Duncan on 8/18/08 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RAKESH K. DHINGRA whose telephone number is (571)272-5959. The examiner can normally be reached on 8:30 -6:00 (Monday - Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Parviz Hassanzadeh can be reached on (571)-272-1435. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Rakesh K Dhingra/  
Examiner, Art Unit 1792

/K. M./  
Primary Examiner, Art Unit 1792